

REMARKS

1. Introduction

In the final Office Action mailed January 31, 2006, the Examiner rejected claims 1-21 under 35 U.S.C. § 103(a) as being unpatentable over Mosher et al., U.S. Patent Application Publication No. 2002/0099790 ("Mosher") in view of Granade et al., U.S. Patent Application Publication No. 2002/0103881 ("Granade"), and further in view of Schwartz et al., U.S. Patent Application Publication No. 2002/0160790 ("Schwartz").

In response, Applicant has amended claims 1, 18, and 19, canceled claims 12-17, and added new claims 22-25. Thus, claims 1-11 and 18-25 are currently pending.

For the reasons set forth below, Applicant requests reconsideration and allowance of the claims, as amended herein.

2. The Advisory Action

Applicant thanks the Examiner for explaining in the Advisory Action why the arguments in the Response After Final mailed March 20, 2006 were deemed unpersuasive. However, it appears that the Examiner has missed the point of Applicant's arguments. In particular, the argument on paragraph 3 of page 3 that "the mobile device might not have a display screen at all" was not intended to refer to a feature recited in the claims but, rather, was intended to refer to an example in the specification that illustrates the difference between *display screen characteristics* and *transmission modes*. In particular, if the mobile device does not have a display screen (and such mobile devices are covered by many of the pending claims) then there are no display screen characteristics. However, there is still the possibility of different *transmission modes* (e.g., high bit-rate and low bit-rate).

It is important to recognize this distinction between display screen characteristics and transmission modes because the Examiner has cited to Schwartz (¶ 60), which teaches that “the HDML files are then processed ... and converted to *screen description data* according to the *device characteristics* of mobile device,” for claim elements that recite a list of available media content that is compatible with the indicated *transmission mode*. Thus, the Examiner has confused display screen characteristics (which relate to how media is displayed on a device) with transmission modes (which relate to how media is transmitted to a device). In order to clarify this distinction, Applicants have amended claims 1, 18, and 19.

3. Response to Claim Rejections

a. Claims 1-11

Of these claims, claim 1 is independent. The Examiner has rejected claim 1 under § 103(a) as being unpatentable over Mosher in view of Granade and further in view of Schwartz. In response, Applicant submits that the Mosher/Granade/Schwartz combination does not teach each and every element in claim 1, as set forth below.

Claim 1, as amended herein, recites *inter alia* “receiving a list of available media content, wherein all media content in the list of available media content is compatible with the indicated transmission mode.” The Examiner has acknowledged that neither Mosher nor Granade discloses this element. See Final Office Action, p. 4. Instead, the Examiner has relied on Schwartz for this element. However, Schwartz teaches generating screen description data for compatibility with *device characteristics* of the mobile device, rather than for compatibility with an indicated *transmission mode*:

From the perspective of mobile device 602 that ultimately receives the information, link server 606 receives the HDML files that are then processed by message processor 610 and *converted to screen description data according to the device characteristics of mobile device 602*. ... During the process of exchanging authentication information, the data carrying the device characteristics of mobile device 602 is received and maintained in link server 606 such that the *screen description data is generated in accordance with the device characteristics of mobile device 602*.

(Schwartz, ¶ 60). Although what transmission modes are available may be limited by device characteristics, transmission modes and device characteristics are two different things.

For example, the available transmission modes may include a “full experience” mode with both audio and video, an “audio-with-stills” mode made up of audio and still images from the video, and an “audio-only” mode (as described in Applicant’s specification at p. 20, line 17 – p. 21, line 5). Even though a wireless handset may be capable of displaying video, a user may choose the “audio-only” mode when the user is driving a car (as described in Applicant’s specification at p. 27, lines 1-5). Thus, compatibility with the display characteristics of a particular device does not necessarily imply compatibility with a user-selected transmission mode.

Because Schwartz is concerned with compatibility with device characteristics, rather than with compatibility with an indicated transmission mode, Applicant submits that the Mosher/Granade/Schwartz combination fails to teach “receiving a list of available media content, wherein all media content in the list of available media content is compatible with the indicated transmission mode.”

Accordingly, Applicant submits that claim 1, as amended, is allowable over Mosher, Granade, and Schwartz for at least the foregoing reasons. Applicant further submits that claims 2-11 are allowable for at least the reason that they depend from an allowable claim.

b. Claim 18

The Examiner has rejected claim 18 under § 103(a) as being unpatentable over Mosher in view of Granade and further in view of Schwartz. In response, Applicant submits that the Mosher/Granade/Schwartz combination does not teach each and every element in claim 18, as set forth below.

Claim 18, as amended herein, recites *inter alia* “selection logic ... to receive from the media server a list of available media content, wherein all media content in the list of available media content is compatible with the selected transmission mode.” The Examiner has acknowledged that neither Mosher nor Granade discloses receiving a list of available media content wherein all media content in the list of available media content is compatible with the indicated transmission mode. *See* Final Office Action, p. 4. Instead, the Examiner has relied on Schwartz for this element. However, as discussed above for claim 1, Schwartz is concerned with compatibility with device characteristics, rather than with compatibility with an indicated transmission mode.

Accordingly, Applicant submits that claim 18, as amended, is allowable over Mosher, Granade, and Schwartz for at least the foregoing reasons.

c. Claims 19-21

Of these claims, claim 19 is independent. The Examiner has rejected claim 19 under § 103(a) as being unpatentable over Mosher in view of Granade and further in view of Schwartz. In response, Applicant submits that the Mosher/Granade/Schwartz combination does not teach each and every element in claim 19, as set forth below.

Claim 19, as amended herein, recites *inter alia* “list logic ... to i) establish a list of available media content, wherein all media content in the list is compatible with the indicated

transmission mode.” The Examiner has acknowledged that neither Mosher nor Granade discloses receiving a list of available media content wherein all media content in the list of available media content is compatible with the indicated transmission mode. See Final Office Action, p. 4. Instead, the Examiner has relied on Schwartz for this element. However, as discussed above for claim 1, Schwartz is concerned with compatibility with device characteristics, rather than with compatibility with an indicated transmission mode.

Accordingly, Applicant submits that claim 19, as amended, is allowable over Mosher, Granade and Schwartz for at least the foregoing reasons. Applicant further submits that claims 20 and 21 are allowable for at least the reason that they depend from an allowable claim.

d. Claims 22-25

Applicant has added new claims 22-25, of which claim 22 is independent. Support for these new claims can be found in various places in the application, e.g., in Figure 3 and in the specification at p. 23, lines 1-16 and p. 24, line 7 – p. 25, line 4. Applicant submits that claims 22-25 are allowable over Mosher, Granade, and Schwartz for at least the foregoing reasons.

The Examiner has cited Mosher as disclosing “presenting on the wireless handset a set of choices indicating transmission modes for streaming media content to the wireless handset.” However, claim 22 recites *inter alia* “determining a list of permissible transmission modes for a selected media content choice, the selected media content choice having been selected by the user from the list of media content choices” and “providing the user with the list of permissible transmission modes for the selected media content choice.” Thus, in claim 22, the user selects a particular media content choice **and then** the transmission modes that are permissible for that particular media content choice are determined and are listed to the user. In contrast, Mosher discloses that the user selects a media asset from available media asset choices **after** the user has

selected criteria such as format and provider. *See* Mosher, Figures 3A – 3G. Applicant further submits that Granade and Schwartz do not make up for this deficiency in Mosher.

Accordingly, Applicant submits that claims 22-25 are allowable over Mosher, Granade, and Schwartz for at least the foregoing reasons.

4. Conclusion

Applicant submits that the present application is in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, the Examiner is invited to telephone the undersigned at any time at (312) 913-0001.

Respectfully submitted,

Date: April 28, 2006

By: Richard A. Machonkin
Richard A. Machonkin
Registration No. 41,962